

Remarks

Claims 1-14 and 16-49 are pending in this application. Claim 15 has been canceled without prejudice or disclaimer. Claims 1-11, 16, 17, 19, 20, 26, and 28-38 have been withdrawn from consideration. Claims 48-49 are newly added.

Claim 19 was withdrawn by the Examiner as being dependent on non-elected claim 16. Reinstatement of claim 19 is respectfully requested in view of its amendment above to depend on elected claim 18.

The disclosure was objected to for some minor informalities relating to labeling of the figures. Withdrawal of the objection is respectfully requested in view of the amendments to the specification above.

It was suggested that an ADS be submitted to clarify continuity data in the declaration. Accordingly, an ADS consistent with the continuity data referred to in the paragraph following the title of the present specification is submitted herewith.

It was further stated in the Office Action that the "Assignment and Agreement" form does not include the signature of inventor Dwight P. Duston. In fact, a corrected Assignment and Agreement form including the signature of inventor Dwight P. Duston was filed on August 26, 2002 and recorded by the Office. A copy of the corresponding documentation is attached for the information of the Examiner.

Claims 12-14, 22, 23, 25, 27 and 44-47 were rejected under 35 USC 102(b) as being anticipated by Amos (US 3,785,102; hereinafter Amos '102). To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). In view of the foregoing authority, the Applicant respectfully submits that Amos '102 does not support the asserted rejection.

Embodiments of the present invention as recited in independent claim 12 relate to a tacky insert having a top tacky exposed outer surface capable of being walked on and cleaning at least a portion of a bottom of a person's shoes. The tacky insert includes apertures therethrough capable of draining water. Accordingly, Amos '102 does not anticipate claim 12 for at least the reason that Amos '102 is completely silent

as to apertures through a tacky insert and capable of draining water as required by claim 12. Moreover, Amos has no mention of water whatsoever. Therefore, claim 12 is allowable over Amos '102.

Claims 13, 14, 22, 23, 25, 27 and 44-47 each incorporates the limitations of claim 12 by dependency. Therefore, claims 13, 14, 22, 23, 25, 27 and 44-47 are likewise allowable over Amos '102 for at least the reason discussed in connection with claim 12.

In view of the foregoing, withdrawal of the rejection of claims 12-14, 22, 23, 25, 27 and 44-47 as anticipated by Amos '102 is respectfully requested.

Claims 39-41 were rejected under 35 USC 103(a) as being unpatentable over Amos '102. To establish a prima facie case of obviousness under § 103, all claim limitations of a claimed invention must be taught or suggested by the prior art. See MPEP, Section 2143.03 and In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Applicant respectfully submits that the cited reference does not establish a prima facie case of obviousness in consideration of the noted authority.

Claims 39-41 each incorporates the features of claim 12 by dependency. As discussed above, Amos '102 does not teach or suggest apertures through a tacky insert and capable of draining water as required by claim 12. Accordingly, claims 39-41 are allowable over Amos '102. Withdrawal of the rejection of claims 39-41 as being unpatentable over Amos '102 is therefore respectfully requested.

Claims 12, 22-24, 46 and 47 were rejected under 35 USC 102(b) as being anticipated by De Guzman (US 4, 917,975; hereinafter De Guzman '975). Further, claims 12, 13, 18, 42 and 43 were rejected under 35 USC 102(b) as being anticipated by Converse (US 2,800,215; hereinafter Converse '215).

Requirements for sustaining a rejection for anticipation have been outlined above. Along lines discussed previously, neither De Guzman '975 nor Converse '215 anticipates the rejected claims for at least the reason that neither discloses apertures through a tacky insert and capable of draining water as required by independent claim 12 and by the claims dependent on it. Therefore, withdrawal of the rejection of claims 12, 22-24, 46 and 47 as being anticipated by De Guzman '975, and of the rejection of claims 12, 13, 18, 42 and 43 as being anticipated by Converse '215, is respectfully requested.

Claims 12, 15 and 21 were rejected as being anticipated by Calhoun (US 5,589,246; hereinafter, Calhoun '246). Claim 15 has been canceled.

As discussed earlier, independent claim 12 recites a tacky insert that includes apertures therethrough capable of draining water. Accordingly, Calhoun '246 does not anticipate claim 12 for at least the reason that Calhoun '246 does not disclose the latter feature.

Calhoun '246 relates to a "heat-activatable adhesive article" -- essentially a tape. The tape has a carrier film 11 and a layer of adhesive 16 on the carrier film. There are projections 18 in the carrier film that project above the adhesive layer.

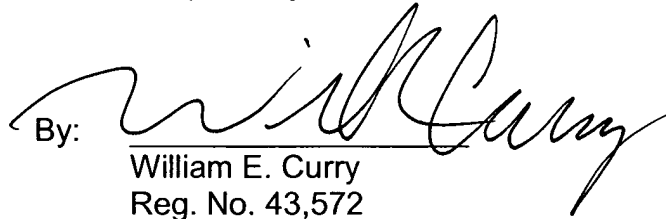
Note is taken of the characterization in the Office Action of the "final product" of Calhoun '246 as having apertures (Office Action, item 12, third paragraph). It is further observed that the Office Action alleges an equivalency between the claimed tacky insert and the "sheet" 11 (carrier film) of Calhoun '246. However, there are no apertures through the carrier film 11. Since the carrier film 11 does not have apertures, it can only be surmised that the Office Action refers to apertures in the adhesive layer 16. However, the Applicant respectfully submits that discontinuities in the adhesive layer 16 of Calhoun '246 through which projections 18 project are in no way the equivalent of the apertures claimed according to the present invention. The discontinuities do not extend through the carrier layer 11, as noted above. Moreover, since layer 16 is an adhesive, it must adhere to the respective bases of the projection 18 and block, rather than allow drainage of, any water on the layer 16. Thus, there is no feature in Calhoun '246 corresponding to a "tacky insert including apertures therethrough capable of draining water" as required by claim 12. Withdrawal of the rejection of claims 12, and of claim 21 dependent thereon, as anticipated by Calhoun '246 is respectfully requested.

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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